

Robert Colin PUGH et al.
Serial No. 10/779,702

Office Action dated 10-21-2005
Atty. Dkt. No. P66775US1

Amendments to the Drawings:

Attached is a sheet of formal drawings containing Fig.18, which has been amended to include the legend "Prior Art" in compliance with the Examiner's requirement.

REMARKS

This is in response to the first Office Action of October 21, 2005. By this Amendment, claims 20 and 30 have been amended and dependent claim 31 has been cancelled. Thus, claims 20-30 and 32-36 remain in the application for further examination.

Filed separately herewith is a Petition for a one-month extension of time along with the requisite fee. Should the fees for the extension be in error, the Office is authorized to debit or credit the undersigned's deposit account No. 06-1358.

In the first Office Action, the Examiner indicated that the foreign patents provided with the Information Disclosure Statement of February 18, 2004, cannot be found in the scanned application. Copies of the foreign patents are resubmitted herewith.

In paragraph 3 of the Office Action, the Examiner stated that "it appears that Figures 12-14 and 18 should be designated by a legend such as -- Prior Art -- ." This is incorrect. Figure 18 should be designated as "Prior Art" and filed separately herewith is a replacement drawing sheet for that figure. However, the remaining figures are certainly not prior art and it is not certain why the Examiner suggests that they are prior art. The patent specification, in referring to Figure 12, refers to a conventional geotube, but an EKG geotube is certainly not conventional. Indeed, this is the subject of claims 30-36 of the present application. There is no prior art which discloses any of the concepts set forth in Figures 12-14. (The lime pile of Figure 14 is not being pursued in this divisional application; however, the Applicant does not accept its designation as prior art.)

Preliminarily, this application is a divisional of U.S. Patent No. 6,736,568 and is directed to the embodiment of Figure 9 (claims 20-29) which is an open drain structure, and the enclosing structures of

Figures 12 and 13, as set forth in claims 30 and 32-36. This latter embodiment discloses a sheath that surrounds a soil or other substrate as a conducting EKG and a second electrode is inserted directly within the substrate, laterally spaced therefrom. Neither of these embodiments is disclosed in the prior art.

The present claims have been amended to parallel, to the extent possible, the claims set forth in the issued patent that were deemed allowable over the Jones and Wrigley references which the Examiner again cites in this Office Action. The newly cited EP '875 reference does not in any way inhibit patentability, as will be described.

With respect to the drain structure embodiment of claims 20-29, there is no drain structure in the prior art that employs an EKG sheath in the manner claimed in independent claim 20. The object of the present invention is that the sheath itself is an electrokinetic geosynthetic which is defined in the application and also defined in an earlier application by the same Applicant. The sheath must functionally be a conductive material. It achieves this either by being an inherently conductive material, or a composite material comprising a non-conductive and conductive material in sufficiently intimate contact or association with each other, so that the overall composite can be considered a conductor.

In the first Office Action, the Examiner rejected claims 20-26, 28-33, 35-36 as anticipated by the EP '875 reference. Reconsideration is respectfully requested. The Examiner, in the rejection, states that the sheath is "associated with at least one conducting element." However, the independent claims have now been amended to recite that the sheath has a conductive element thereon to be in direct contact with the substrate, thus making the sheath itself a conductive element. This clearly distinguishes the claims from the EP '875 reference. Although the EP '875 reference shows a sheath, the sheath is a conventional non-conducting

drainage sheath and not a conducting geosynthetic sheath as claimed. With respect to independent claim 30, the second electrode that is inserted within the core is now positively recited and must be given patentable weight. The structural elements recited in claim 30 are not found in the EP '875 reference, nor in any other cited reference.

In the first Office Action, claims 20-36 were also rejected as anticipated by the Jones et al. reference. This reference was considered during the examination of the parent patent and the claims thereof were allowed. For the same reasons, the claims should be allowed in the present case. As was discussed in the prosecution of the parent patent, the Jones application is Applicant's own prior application and describes for the first time the advantages of providing a conductive electrokinetic geosynthetic ("EKG") material. However, Jones does not disclose an EKG structure comprising geosynthetic material with at least one core element substantially enclosed by the sheath, at least in the detail as now claimed. Certainly nothing in Jones is directed to the embodiment claimed in independent claim 30.

In the first Office Action, the Examiner rejects claims 20-36 as anticipated by the Wrigley PCT application. Reconsideration is respectfully requested. The Wrigley reference was also cited during the parent prosecution and therein it was pointed out that Wrigley is not prior art with respect to the present invention. The Wrigley application was published on December 30, 1998. Although it bears an international filing date of June 23, 1998, that is not the effective date of the reference. Because the international application was not filed after November 29, 2000, it is not prior art under 35 U.S.C. §102(e). Its effective date as a prior art reference is its publication date of December 30, 1998. Because the present application has priority to a British application filed December 23, 1998, and if the present application is supported by the British priority

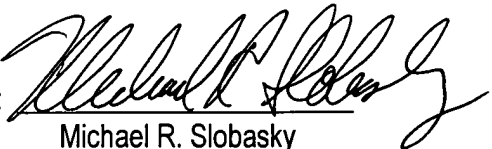
application, the Wrigley reference would be removed. It was requested in the parent application and is requested again that the Examiner should check the British priority application which was submitted by the International Bureau to the U.S. PTO. In any event, the claims as amended provide distinctions over the Wrigley reference.

Claims 27 and 34 were rejected as obvious over EP '875, in view of the Jones et al. reference. For the reasons set forth above, reconsideration is respectfully requested. It would not be obvious to combine the references and, even if combined, would not render obvious the two dependent claims at issue.

Based upon the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for examination. Should the Examiner have any questions or comments, the Examiner is cordially invited to telephone the undersigned attorney so that an early Notice of Allowance may be received.

Respectfully submitted,

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Attachments: EP 0870875 (in English)
English Abstracts for: JP 07018654, JP 02243816, JP 10110426, UK 2301311